



Paper No. 7

Leslie A. Mooi  
HYSEQ, INC.  
670 Almanor Avenue  
Sunnyvale, CA 94085

**COPY MAILED**

**JUL 23 2002**

**OFFICE OF PETITIONS**

In re Application of  
Godbole et al.  
Application No. 09/788,051  
Filed: February 16, 2001  
Attorney Docket No. HYS-39

DECISION REFUSING STATUS  
UNDER 37 CFR 1.47(a)

This is in response to the petition under 37 CFR §1.47(b), filed April 5, 2002. This petition will be treated under 37 CFR §1.47(a).<sup>1</sup>

The petition under 37 C.F.R. §1.47(a) is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 C.F.R. §1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **Failure to respond will result in abandonment of the application.** Any extensions of time will be governed by 37 C.F.R. §1.136(a).

The above-identified application was filed on February 16, 2001, without an executed oath or declaration. Accordingly, on September 5, 2001, applicant was mailed a "Notice to File Missing Parts of Nonprovisional Application - Filing Date Granted," requiring an executed oath or declaration in compliance with §1.63, and a surcharge for its late filing. This Notice set a two-month period for reply of September 10, 2001.

In reply, applicant filed a petition, declaration and power of attorney, petition fee and the surcharge for late filing of the declaration. To make the reply timely, a five month extension of time was also submitted. In support of the petition, applicants submitted a statement of facts and a copy of correspondence to the non-signing inventor.

A grantable petition under 37 C.F.R. §1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§115 and 116; (3) the

---

<sup>1</sup> Where at least one inventor has signed an oath or declaration it is appropriate for the petition to be treated under 37 CFR §1.47 (a). A petition filed under 37 CFR §1.47(b) is appropriate where all inventors have either refused to execute the oath or declaration, or cannot be located.

petition fee; and (4) a statement of the last known address of the non-signing inventor.

The instant petition does not satisfy requirements (1).

As to item (1), Rule 47 applicant has failed to show that the inventor Godbole refused to sign the declaration after having been presented with the application papers. The letter mailed to non-signing inventor Godbole only indicates the Declaration & Power of Attorney papers were presented to the non-signing inventor. Before a refusal can be alleged, applicant must demonstrate a bona fide attempt was made to present a copy of application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor. See MPEP 409.03(d).

Thus on renewed petition, applicant must establish the **entire** application package (including specification, claims and drawings) was presented to the non-signing inventor and she refused to sign.


Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents  
Box DAC  
Washington, D.C. 20231

By FAX: (703) 308-6916  
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23  
2201 S. Clark Place  
Arlington, VA

Telephone inquiries related to this decision may be directed to Petitions Attorney Charlema R. Grant at (703) 306-0251.

  
Beverly M. Flanagan  
Supervisory Petitions Examiner  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy